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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,292	12/10/2001	Laurence E. Holt	1044.012US1	8482
23441	7590	04/13/2004	EXAMINER	
LAW OFFICES OF MICHAEL DRYJA 704 228TH AVENUE NE PMB 694 SAMMAMISH, WA 98074			YOUNG, JOHN L	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/683,292	HOLT, LAURENCE E.
	Examiner	Art Unit
	John L Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 December 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

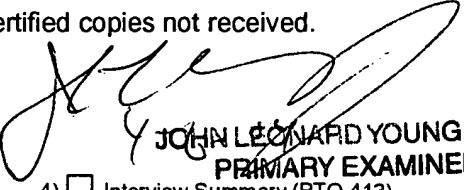
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3 & 5.



JOHN LEONARD YOUNG, ESQ.  
**PRIMARY EXAMINER**

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## FIRST ACTION REJECTION

### DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### CLAIM REJECTIONS – 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 1-20 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per claims 1-20, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*,

167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) even though said claims may be limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

This claim language is merely non-functional descriptive material disembodied from the technological arts.

#### **CLAIM REJECTION – 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. §103( a ) as being obvious over Ferguson US 5,819,092; class 717/113 [cross ref. class 705/39] (Oct. 06, 1998) (herein referred to as ("Ferguson").

As per independent claim 1, Ferguson (FIG. 18; FIG. 19; col. 10, ll. 1-10; col. 11, ll. 9-26; and col. 28, ll. 53-67) shows “registering by a plurality of users with an information provider, where personal information regarding the plurality of users is stored by the information provider. . .”

Ferguson (the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 10, ll. 1-10; col. 11, ll. 9-26; col. 12, ll. 33-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 28, ll. 53-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 18; FIG. 19; FIG. 23; and FIG. 24; and whole document) shows the elements and limitations of claim 1.

Ferguson lacks an explicit recitation of “paying by the information provider to each of the sub-plurality of the plurality of users a portion of an amount collected by the information provider form the organization for access to the desired sub-set of the personal information regarding the user.”

It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Ferguson (the ABSTRACT; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 31, ll. 30-45; and col. 34, ll. 13-17) would have been selected in accordance “paying by the information provider to each of the sub-plurality of the plurality of users a portion of an amount collected by the information provider from the organization for access to the desired sub-set of the personal information regarding the user. . . .” because such selection would have provided means where “*a user may be paid for certain actions.*” (See Ferguson (col. 4, ll. 62-67)).

As per claim 2, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 2. Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 2 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 2 because such combination would have provided means where “*a user may be paid for certain actions.*” (See Ferguson (col. 4, ll. 62-67)).

As per claim 3, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 3.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 3 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 3 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 4, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 4.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 4 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 4 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 5, Ferguson shows the method of claim 4. (See the rejection of claim 4 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 5.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 5 were notoriously well known and expected in the art at the time of the

invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 5 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 6, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 6.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 6 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 6 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 7, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 7.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 7 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 7 because such combination would

have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 8, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 8.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 8 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 8 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 9, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 9.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 9 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 9 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 10, Ferguson shows the method of claim 1. (See the rejection of claim 1 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 10.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 10 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 10 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

Independent claim 11 is rejected for substantially the same reasons as independent claim 1.

As per independent claim 11, Ferguson (the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 12, ll. 33-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 23; and FIG. 24; and whole document) shows elements that suggest the elements and limitations of claim 11.

Ferguson lacks an explicit recitation of "providing a predetermined compensation to at least one Internet computer user entity for correctly responding to said at least one question relating to said at least one commercial email message. . . ."

It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Ferguson (the ABSTRACT; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 31, ll. 30-45; and col. 34, ll. 13-17) would have been selected in accordance with "providing a predetermined compensation to at least one Internet computer user entity for correctly responding to said at least one question relating to said at least one commercial email message. . ." because such selection would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 12, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 12. Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 12 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 12 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 13, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 13.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 13 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 13 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 14, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).  
Ferguson lacks an explicit recitation of the elements and limitations of claim 14.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 14 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 14 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 15, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).  
Ferguson lacks an explicit recitation of the elements and limitations of claim 15.  
Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 15 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 15 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per independent claim 16, Ferguson (col. 10, ll. 1-12; col. 12, ll. 22-27; and col. 28, ll. 43-51) discloses secure, authenticated electronic transaction techniques as is well known in the art. . . . encryption. . . . encrypt and decrypt files. . . .”

Ferguson (FIG. 18; FIG. 19; col. 10, ll. 1-12; col. 11, ll. 9-26; col. 12, ll. 22-27; and col. 28, ll. 43-67) shows “registering by a user with an information provider, where personal information of the user is encrypted by the information provider; storing locally at the user the personal information of the user as encrypted; subscribing by an organization with the information provider for access to a decryption key for decrypting the personal information of the user; requesting a desired sub-set of the personal information of the user by the organization to the user; providing the organization with the desired sub-set of the personal information as encrypted by the user, the organization decrypting the desired sub-set of the personal information. . . .”

Ferguson (the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 10, ll. 1-12; col. 11, ll. 9-26; col. 12, ll. 22-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 28, ll. 43-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 18; FIG. 19; FIG. 23; and FIG. 24; and whole document) shows the elements and limitations of claim 16.

Ferguson lacks an explicit recitation of “paying by the organization to the information provider for access to the desired sub-set of the personal information; and paying by the information provider to the user apportion of an amount collected by the information provider from the organization for access to the desired sub-set of the personal information regarding the user.” It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Ferguson (the

ABSTRACT; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 31, ll. 30-45; and col. 34, ll. 13-17) would have been selected in accordance of “paying by the organization to the information provider for access to the desired sub-set of the personal information; and paying by the information provider to the user apportion of an amount collected by the information provider from the organization for access to the desired sub-set of the personal information regarding the user. . . .” because such selection would have provided means where *“a user may be paid for certain actions.”* (See Ferguson (col. 4, ll. 62-67)).

As per claim 17, Ferguson shows the method of claim 16. (See the rejection of claim 16 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 17. Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 17 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 17 because such combination would have provided means where *“a user may be paid for certain actions.”* (See Ferguson (col. 4, ll. 62-67)).

As per claim 18, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 18.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 18 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 18 because such combination would have provided means where *“a user may be paid for certain actions.”* (See Ferguson (col. 4, ll. 62-67)).

As per claim 19, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 19.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 19 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 19 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

As per claim 20, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 20.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 20 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 20 because such combination would have provided means where "*a user may be paid for certain actions.*" (See Ferguson (col. 4, ll. 62-67)).

## CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450

Application/Control Number: 09/683,292  
Art Unit: 3622

Holt

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Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

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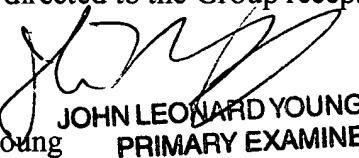
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

2451 Crystal Drive  
Arlington, Virginia.

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young

JOHN LEONARD YOUNG, ESQ.  
**PRIMARY EXAMINER**

Primary Patent Examiner

April 6, 2004